

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

REMARKS/ARGUMENTS

By the above amendment, the Applicant has amended Claims 1 and 9, cancelled Claim 4 to more particularly define the invention in a patentable manner over the cited prior art.

The References And Differences Of The Present Invention Thereover

Prior to discussing the amended claims, applicant will first discuss the references and the general novelty of the present invention and its unobviousness over the references.

The Rejection Of Claim 1 On Deaton In View Of Sloane Is Overcome

The last O.A. rejected Claim 1 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Applicant requests withdrawal of this rejection for the following reasons:

1. Neither Deaton nor Sloane teach using past shopping behavior metrics to encourage the purchase of products.
2. There is explicit teaching away from such combination.
3. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
4. The references themselves teach away by implication from the suggested combination.
5. Even if Deaton and Sloane were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 1.
6. The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references.
7. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.
8. Thus Claim 1 is allowable.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

Neither Deaton Nor Sloane Teach Using Customer Behavior Motivation Metrics To Encourage The Purchase Of Products

Sloane teaches a method that offers incentives to a shopper which are preloaded from the retailer/manufacturer's computers into a controller that determines if a consumer will receive notification of an incentive being offered. The loading of these incentives happens prior to the shopper scanning a product and is in no way customized to the behavior of each shopper and the concerns of each manufacturer. Sloane fails to teach a system for delivering shopping incentives individually customized to influence each customer.

Deaton teaches a system for delivering incentives based on current purchases (scanned at point of sale) and customer past purchase history. The past purchase history described by Deaton is limited to only tracking the items purchased in previous shopping trips.

Neither Deaton nor Sloane describe tracking other past shopping behavior metrics such as past incentives redeemed, past incentives refused, or a plurality of items first scanned within a product category on each shopping trip. The purchase history described by Deaton and Sloane falls far short of the metrics tracked by the present invention.

When current purchase data is used to establish an incentive, i.e. as captured at the point-of-sale register as described by Deaton, the incentive is inherently less effective because it is being offered after the "what to buy" decision moment of that shopping trip has already passed. The present invention disregards such "current purchase" data as inferior and irrelevant for determining an effective incentive.

The present invention is novel and produces unexpected results by going beyond using simple past purchase history. To establish precise shopping behavior metrics the present invention considers the details of past items first scanned within a product class, and combines this data with the past incentives offered but refused, and past incentives

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

ultimately redeemed. Neither Deaton nor Sloane describe capturing this complex data. The present invention can use this unique collection of data to establish customer behavior metrics for each individual shopper that establish the efficacy of past incentives and their ability get each consumer to abandon (or retain) their first product choice.

There Is Explicit Teaching Away From Such Combination

Sloane explicitly teaches away from combining or integrating with any system that distributes coupons with certain key attributes. As explained in Sloane:

“U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit.” (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method of dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes its system to be superior and inherently incompatible with one such as that described by Deaton.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found in Sloane.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

References teach away from combination. As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane however describes a system that is used to scan products while still shopping, specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

References each capture information about a customer's purchase at distinctly different moments in the shopping process. While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures product information at the final moment when a purchase is being made.

This is a significant difference since Deaton's system relies on only passing actual current and past purchase information to the manufacturer controlled incentive engines. If one were to combine Sloane and Deaton a customer using a wireless scanner while shopping would periodically scan a product they would then change their mind about purchasing. This would not work in the system described by Deaton.

Given the discrepancies in when data is captured these references teach away from each other by implication.

References have completely different time frames for providing customer purchase information to the manufacturer. Sloan describes a system that provides static incentives to a customer based upon searching through a preloaded non-dynamic collection of incentives on a remote server or database. As such, any information a manufacturer will capture about the shopper is received long after the shopping and ultimate purchase has taken place. Deaton describes a system that provides product purchase information to the manufacturer at the moment the purchase is being completed. Given the discrepancies in the systems for capturing data and when said data is provided to the manufacturers these references teach away from each other by implication.

References have completely different systems for determining the incentives that should be offered to a customer. Sloane teaches a system where incentives are selected from among those that have been preloaded into a server or database. Deaton describes a system that delivers shopping incentives which are generated by a plurality of

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in the systems for determining the incentives to offer these references teach away from each other by implication.

References have completely different means of delivering incentives to customers. Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a system that offers custom incentives printed at the register after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Given the discrepancies in the systems for delivering incentives these references teach away from each other by implication.

References have dramatically different descriptions regarding integration with traditional Point of Sale systems. Deaton teaches a system that is very tightly integrated with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the Deaton system depends on data collected at the point of purchase and not during the shopping process it depends on this configuration. Sloane, on the other hand, describes a system that is designed to replace the traditional POS system seen today and instead teaches a system with consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton And Sloane Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 1.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

Even if the combination of Deaton and Sloane were legally justified, claim 1 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 1 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane. Those features including a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 1 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane and Deaton.

The new and unexpected results is a system for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton And Sloane.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

The novel features of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

Dependent Claims 2, 3, 5, 7, And 8 Are A Fortiori Patentable Over Sloane

The last O.A. rejected dependent Claims 2, 3, 5, 7, and 8 on the teachings of Sloane (U.S. Patent No. 5,918,211). Original dependent claims 2, 3, 5, 7, and 8 incorporate all the subject matter of Claim 1 and add additional subject matter, which makes them a fortiori and independently patentable over this reference.

The Rejection Of Claim 9 On Deaton In View Of Sloane Is Overcome

The last O.A. rejected Claim 9 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Applicant requests withdrawal of this rejection for the following reasons:

1. Neither Deaton nor Sloane teach using past shopping behavior metrics to encourage the purchase of products.
2. There is explicit teaching away from such combination.
3. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
4. The references themselves teach away by implication from the suggested combination.
5. Even if Deaton and Sloane were to be combined in the manner proposed, the proposed combination would not show all of the novel features of Claim 9.
6. The novel features of Claim 9 produce new and unexpected results and hence are unobvious and patentable over these references.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

7. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.
8. Thus Claim 9 is allowable.

Neither Deaton Nor Sloane Teach Using Customer Behavior Motivation Metrics To Encourage The Purchase Of Products

Sloane teaches a method that offers incentives to a shopper which are preloaded from the retailer/manufacturer's computers into a controller that determines if a consumer will receive notification of an incentive being offered. The loading of these incentives happens prior to the shopper scanning a product and is in no way customized to the behavior of each shopper and the concerns of each manufacturer. Sloane fails to teach a method for delivering shopping incentives individually customized to influence each customer.

Deaton teaches a method for delivering incentives based on current purchases (scanned at point of sale) and customer past purchase history. The past purchase history described by Deaton is limited to only tracking the items purchased in previous shopping trips.

Neither Deaton nor Sloane describe tracking other past shopping behavior metrics such as past incentives redeemed, past incentives refused, or a plurality of items first scanned within a product category on each shopping trip. The purchase history described by Deaton and Sloane falls far short of the metrics tracked by the present invention.

When current purchase data is used to establish an incentive, i.e. as captured at the point-of-sale register as described by Deaton, the incentive is inherently less effective because it is being offered after the "what to buy" decision moment of that shopping trip has already passed. The present invention disregards such "current purchase" data as inferior and irrelevant for determining an effective incentive.

The present invention is novel and produces unexpected results by going beyond using simple past purchase history. To establish precise shopping behavior metrics the present

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

invention considers the details of past items first scanned within a product class, and combines this data with the past incentives offered but refused, and past incentives ultimately redeemed. Neither Deaton nor Sloane describe capturing this complex data. The present invention can use this unique collection of data to establish customer behavior metrics for each individual shopper that establish the efficacy of past incentives and their ability get each consumer to abandon (or retain) their first product choice.

There Is Explicit Teaching Away From Such Combination

Sloane explicitly teaches away from combining or integrating with any method that distributes coupons with certain key attributes. As explained in Sloane:

“U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit.” (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method of dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system,

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

accurately describe those found in Deaton's. Sloane describes its method to be superior and inherently incompatible with one such as that described by Deaton.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found in Sloane.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

References teach away from combination. As indicated in the O.A., "Deaton determines incentives based on current purchases (scanned at point of sale)". Sloane however describes a method that is used to scan products while still shopping, specifically identified as "Point-of-Purchase" whereby products are only selected and their ultimate purchase remains in question and open to influence. Sloane even discusses the distinction between the term point-of-sale as used by Deaton.

"Promotional offers and coupon distribution for competitive products serve to alter the consumer's future purchasing behavior. The most widely used example of this involves coupons printed and distributed at the supermarket or retailer checkout counter based on the items that are purchased (i.e., point-of-sale). These issued coupons must be used on a subsequent trip to the supermarket or retail establishment." (Column 1, Lines 44-50)

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

As described in Sloane products would not be purchased until the consumer returns the portable bar code scanner to the scanner center. Since the scanner would now be returned and no longer in the possession of the consumer all incentives would again have to be delivered after the shopping is completed as described in Deaton.

References each capture information about a customer's purchase at distinctly different moments in the shopping process. While Sloane allows for the capture of product UPC codes during the product selection phase, Deaton instead captures product information at the final moment when a purchase is being made.

This is not an insignificant difference since Deaton's method relies on only passing actual current and past purchase information to the manufacturer controlled incentive engines. If one were to combine Sloane and Deaton a customer using a wireless scanner while shopping would periodically scan a product they would then change their mind about purchasing. This would not work in the method described by Deaton.

Given the discrepancies in when data is captured these references teach away from each other by implication.

References have completely different time frames for providing customer purchase information to the manufacturer. Sloan describes a method that provides static incentives to a customer based upon searching through a preloaded non-dynamic collection of incentives on a remote server or database. As such, any information a manufacturer will capture about the shopper is received long after the shopping and ultimate purchase has taken place. Deaton describes a method that provides product purchase information to the manufacturer at the moment the purchase is being completed. Given the discrepancies in the methods for capturing data and when said data is provided to the manufacturers these references teach away from each other by implication.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

References have completely different methods for determining the incentives that should be offered to a customer. Sloane teaches a method where incentives are selected from among those that have been preloaded into a server or database. Deaton describes a method that delivers shopping incentives which are generated by a plurality of independently competing manufacturer controlled dynamic offer engines that customize each incentive to meet manufacturer objectives. Given the discrepancies in the methods for determining the incentives to offer these references teach away from each other by implication.

References have completely different means of delivering incentives to customers. Sloane teaches displaying incentives directly on a wireless device in the store while shopping. Deaton teaches a method that offers custom incentives printed at the register after the purchase is complete, delivered via email some time after the shopping is done, or alternatively printed at a kiosk in the store during the next shopping visit. Given the discrepancies in the methods for delivering incentives these references teach away from each other by implication.

References have dramatically different descriptions regarding integration with traditional Point of Sale systems. Deaton teaches a method that is very tightly integrated with the traditional existing store POS system with a cash register and scanner at the end of a check out isle. As the Deaton method depends on data collected at the point of purchase and not during the shopping process it depends on this configuration. Sloane, on the other hand, describes a method that is designed to replace the traditional POS system seen today and instead teaches a method with consumer self directed checkout that maintains a running total of purchases as a customer shops throughout the store. Given the discrepancies in utilization of traditional POS systems versus cart focused consumer directed checkout these references teach away from each other by implication.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton And Sloane Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 9.
Even if the combination of Deaton and Sloane were legally justified, Claim 9 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 9 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane. Those features including a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 9 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of Claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane and Deaton.

The new and unexpected results is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton And Sloane.

The novel features of Claim 9 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton and Sloane.

Dependent Claims 2-5, 7, And 8 Are A Fortiori Patentable Over Deaton In View Of Sloane

The last O.A. rejected dependent Claims 2-5, 7, and 8 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Original dependent claims 2-5, 7, and 8 incorporate all the subject matter of Claim 1 and add additional subject matter, which makes them a fortiori and independently patentable over this reference.

Dependent Claims 10-13, 15 And 16 Are A Fortiori Patentable Over Deaton In View Of Sloane

The last O.A. rejected dependent Claims 10-13, 15 and 16 on the teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211). Original dependent claims 10-13, 15 and 16 incorporate all the subject matter of Claim 9 and add additional subject matter, which makes them a fortiori and independently patentable over this reference.

The Rejection Of Dependent Claim 6 In View Of Deaton In View Of Sloane And Further In View Of Antilla Is Overcome

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

The last O.A. rejected dependent Claim 6 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. Claim 1 already overcomes Deaton and Sloane
2. There is explicit teaching away from such combination (Sloane and Deaton)
3. There is no suggestion to combine these references.
4. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
5. The references themselves teach away by implication from the suggested combination.
6. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 6.
7. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

Claim 1 Already Overcomes Deaton And Sloane

Applicant submits that as Claim 1 already overcomes Deaton and Sloane the addition of a wireless device as generating a bar code to be scanned by a point of sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.

There Is Explicit Teaching Away From Such Combination

Sloane explicitly teaches away from combining or integrating with any system that distributes coupons with certain key attributes. As explained in Sloane:

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the system for dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes its system to be superior and inherently incompatible with one such as that described by Deaton.

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found in Sloane.

There Is No Suggestion To Combine These References

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 6 incorporates all the subject matter of claim 1 and adds additional subject matter. Applicant submits that since claim 1 overcomes Deaton and Sloane claim 6 is already a fortiori and independently patentable over Deaton in view of Sloane regardless of Antilla. That all noted references teach a method for

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified by adding Deaton's independently competing manufacturer controlled dynamic offer engines and Anttilla's scannable bar code display.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane and Deaton already teach strongly away from each other (as noted above). The addition of the feature from Anttilla does not overcome the teaching away of Sloane and Deaton and further teaches away from addition to Sloane. The integration of Deaton and Sloane, as suggested by the O.A., would eliminate the traditional POS system as described in Deaton and instead would create a system with an integrated hand held wireless customer self actuated POS system. It would be illogical to add a scannable barcode display to the wireless device of this resultant system since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

Even If Deaton, Sloane, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 6.

Even if the combination of Deaton, Sloane, and Anttilla were legally justified, claim 6 incorporating all the subject matter of Claim 1 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 6 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane and then adding a scannable bar code display.

The new and unexpected results is a system that integrates seamlessly with traditional POS systems that delivers shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

These Novel Features Of Claim 6 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 6 incorporating all the subject matter of claim 1 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected results is a system that integrates seamlessly with traditional POS systems that delivers shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, And Anttilla.

The novel features of claim 6 incorporate all the subject matter of claim 1 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Anttilla.

The Rejection Of Dependent Claim 14 In View Of Deaton In View Of Sloane And Further In View Of Anttilla Is Overcome

The last O.A. rejected dependent claim 14 on the combined teachings of Deaton (U.S. Patent No. 6,292,786) in view of Sloane (U.S. Patent No. 5,918,211) and further in view of Anttilla (U.S. Patent No. 6,862,575). Applicant requests reconsideration and allowance over this rejection for the following reasons:

1. Claim 1 already overcomes Deaton and Sloane
2. There is explicit teaching away from such combination (Deaton and Sloane)
3. There is no suggestion to combine these references.
4. The references take mutually exclusive paths and reach different solutions to a similar problem therefore, by implication, each teaches away from combining itself with the other. Since they teach away from each other it would not be logical to combine them.
5. The references themselves teach away by implication from the suggested combination.
6. Even if the references were to be combined in the manner proposed, the proposed combination would not show all of the novel features of claim 14.
7. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane and Anttilla.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

Claim 1 Already Overcomes Deaton And Sloane

Applicant submits that as claim 9 already overcomes Deaton and Sloane the addition of a wireless device as generating a bar code to be scanned by a point of sale, as suggested by Anttilla, brings forth the same arguments made above against combining references.

There Is Explicit Teaching Away From Such Combination

Sloane explicitly teaches away from combining or integrating with any method that distributes coupons with certain key attributes. As explained in Sloane:

"U.S. Pat. Nos. 4,910,672, 4,723,212, and 5,173,851, assigned to Catalina Marketing Corporation, disclose methods of dispensing coupons, including coupons for competitive products, based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter, and connected to point-of-sale electronic system. Each of the systems disclosed require the use of checkout counter scanners, which are used as point-of-sale devices.

The prior art methods of distributing consumer promotions and coupons, based on checkout scanner information, in an effort to affect future purchasing behavior are inefficient. This inefficiency is due to the fact that a substantial number of the issued discounts or coupons go unused because consumers are required to remember to bring them to the store on their next visit." (Column 1, Lines 51-67)

These key elements referenced above in Sloane, namely the method of dispensing coupons based on a consumer's purchases as they are identified by the bar code scanner mounted inside the checkout counter connected to point-of-sale electronic system, accurately describe those found in Deaton's. Sloane describes its system to be superior and inherently incompatible with one such as that described by Deaton.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

A person of ordinary skill in the art would have been discouraged from combining these individual elements given the explicit teaching away from such a combination as found in Sloane.

There Is No Suggestion To Combine These References

As noted above, there is ample case law that discusses impermissible hindsight vision afforded by the claimed invention.

In the present case, there is no reason given in the last O.A. to support the proposed combination. The original dependent claim 14 incorporates all the subject matter of claim 9 and adds additional subject matter. Applicant submits that since claim 9 overcomes Deaton and Sloane claim 14 is already a fortiori and independently patentable over Deaton in view of Sloane regardless of Anttilla. That all noted references teach a method of providing a discount offer is not sufficient to gratuitously and selectively substitute parts of one reference for parts of other references in order to meet applicant's novel claimed combination, as exemplified by adding Deaton's independently competing manufacturer controlled dynamic offer engines and Anttilla's scannable bar code display.

References Take Mutually Exclusive Paths And Reach Different Solutions To A Similar Problem Therefore, By Implication, Each Teaches Away From Combining Itself With The Other. Since They Teach Away From Each Other It Would Not Be Logical To Combine Them.

The common objective of offering an incentive to a customer falls short of providing justification to combine the references. Furthermore, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.

Sloane and Deaton already teach strongly away from each other (as noted above). The addition of another feature from Anttilla does not overcome the teaching away of Sloane and Deaton and, furthermore, fails to add any value to the combination even if it were permitted. The integration of Deaton and Sloane, as suggested by the O.A., would

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

eliminate the traditional POS system as described in Deaton and instead would create a method using an integrated hand held wireless customer self actuated POS system. It would be illogical to add a scannable barcode display to the wireless device of this type since there would be no traditional POS system to scan the barcodes on said display. This lack of logical combination additionally teaches away from such a combination.

Since the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified the teachings of the references are not sufficient to render the claims prima facie obvious.

Even If Deaton, Sloane, And Anttilla Were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Features Of Claim 14.

Even if the combination of Deaton, Sloane, and Anttilla were legally justified, claim 14 incorporating all the subject matter of claim 9 would still have novel (and unobvious) features over the proposed combination. In other words applicant's invention as defined by Claim 14 comprises much more than starting with Deaton and adding the wireless scanning device as described in Sloane and then adding a scannable bar code display.

The new and unexpected result is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made, whereby said incentives are further seamlessly redeemable by traditional POS systems.

Appl. No. 10/071,537
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

These Novel Features Of Claim 14 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References.

Also applicant submits that the novel features of claim 14 incorporating all the subject matter of claim 9 are also unobvious and hence patentable under § 103 since they produce new and unexpected results over Sloane, Deaton, and Anttilla.

The new and unexpected result is a method for delivering shopping incentives individually customized to influence each customer for products having machine readable codes whereby the incentives are generated by a plurality of independently competing manufacturer controlled dynamic incentive offer engines that use customer behavior data received from said processing application and further customize each incentive to meet the manufacturer's internal concerns and objectives, and where the incentives are presented to the customer at the time a purchase decision is being made, whereby said incentives are further seamlessly redeemable by traditional POS systems.

It Would Not Have Been Obvious To One Having Ordinary Skill In The Art To Combine Deaton, Sloane, And Anttilla.

The novel features of claim 14 incorporate all the subject matter of claim 9 produce new and unexpected results and hence are unobvious and patentable over these references. It would not have been obvious to one having ordinary skill in the art to combine Deaton, Sloane, and Anttilla.

Non-Applied References

Regarding U.S. Patent No. 6,327,570 to Stevens, U.S. Patent No. 6,434,530 to Sloane, U.S. Patent No. 6,314,406 to O'Hagan, and U.S. Patent No. 5,250,789 to Johnsen, I have reviewed these patents and found that they do not show the current patent and fail to render it obvious.

Appl. No. 10/071,637
Response dated December 17, 2007
Reply to Advisory Action of September 14, 2007

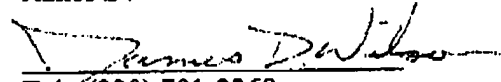
Conclusion

In view of the above it is submitted that the claims are in condition for allowance.
Reconsideration and allowance of the objections is respectfully requested.

Conditional Request For Constructive Assistance

Applicant has amended the claims of this specification so that they are proper, definite, and define a novel system and method, which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,
James D. Wilson


Tel. (330) 701-3369